

REMARKS/ARGUMENTS

Claims 1-34 and 36-49 are currently pending and stand rejected as being anticipated. Claims 1-34 and 36-47 also stand rejected as being indefinite, and claims 1-34, 36, and 39-47 stand rejected as being directed to non-statutory subject matter.

Claims 1, 5, 6, 9, 10, 14, 33, 34, 36-39, 43, and 47-49 have been amended herein, and such amendments are supported by the specification and drawings. Examiner's rejections are addressed in turn. For the reasons stated below, Applicants respectfully request withdrawal of these rejections and allowance of claims 1-34 and 36-49.

Claim Objections

Claim 6, which was objected to for grammatical reasons, has been amended. Applicants respectfully request that the objection be removed.

Rejection under 35 U.S.C. § 112

Claims 1-34 and 36-47 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the rejection states that "the body of [claim 1] does not recite steps pertaining to predicting a level of consumption of healthcare resources by modeling utilization of healthcare resources."

Claim 1 has been amended to recite a "burden of illness score" and a "utilization score." The recited "utilization score" represents the level of consumption prediction and is computed "based on the burden of illness" and "at least one explanatory variable." Moreover, the "burden of illness score" is based on the modeling of a plurality of provider claims from a base period maintained for a member of a healthcare plan. Accordingly, the claim recites a method "for predicting a level of consumption of healthcare resources by modeling utilization of healthcare resources..."

In light of the foregoing, Applicants respectfully request that the § 112 rejection be withdrawn.

Rejection under 35 U.S.C. § 101

Claims 1-34, 36, and 39-47 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, Examiner asserts:

[C]laim 1...does not recite any steps beyond computing a score. It is unclear what is done with the score once the method is completed (i.e., is it used to predict patients consuming healthcare resources?).

Office Action dated 11/02/2005 page 4. The rejection concentrates exclusively on the last recited step of computing patient utilization scores, arguing that “[i]t is unclear what is done with the score once the method is completed...”

Applicants respectfully assert that a proper analysis of 35 U.S.C. § 101 in accordance with MPEP § 2106 et seq. (“Patentable Subject Matter – Computer-Related Inventions”) provides for statutory process claims regardless of whether the physical objects or activities that are measured occur before or after the computer process activity. Specifically, MPEP § 2106(IV)(B)(2)(b) states, “A claimed process is clearly statutory if it results in a physical transformation outside the computer, i.e., falls into one or both of the following specific categories,” including “Independent Physical Acts (Post-Computer Process Activity)” and “Manipulation of Data Representing Physical Objects or Activities (Pre-Computer Process Activity)”. The “Pre-Computer Process Activity” section provides that “[a]nother statutory process is one that requires the measurements of physical objects or activities to be transformed outside of the computer into computer data ... where the data comprises signals corresponding to physical objects or activities external to the computer system, and where the process causes a physical transformation of the signals which are intangible representations of the physical objects or activities.” The same guiding principles are provided in the Examination Guidelines for Computer-Related Inventions, A-2, which include the following flowchart steps:

“Performs independent physical acts (post-computer process activity)”

or

“Manipulates data representing physical objects or activities to achieve a practical application (pre-computer process activity)”

As seen in the EGCRI flowchart, see Appendix A, an affirmative response to either of the above boxes yields “Statutory Subject Matter.”

Accordingly, the rejection's assertion that "[i]t is unclear what is done with the score once the method is completed..." is not dispositive because transforming measurements of outside physical activities that occurred prior to the computer processing into computer data also constitutes statutory subject matter. Moreover, "calculating a burden of illness score...based on the plurality of provider claims [for a member of a healthcare plan]" represents "the measurements of [pre-computer process activity] physical objects or activities to be transformed outside of the computer into computer data," and therefore claim 1 constitutes statutory subject matter in accordance with MPEP § 2106(IV)(B)(2)(b).

Rejection under 35 U.S.C. § 102

Claims 1-5, 16, 18-24, 27-32, 36-37, 39-47 and 48-49 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lash (US 2001/0020229 A1). Applicants respectfully oppose these rejections. The cited reference fails to teach each and every element of every claim as required by MPEP § 2131. For at least this reason, the § 102 rejection is unsupported by the art and should be withdrawn.

Claim 1 recites, "a plurality of utilization scores is computed that correspond to each of a plurality of members in a health plan." Lash fails to teach computing a plurality of scores for each member in a health plan; rather the references describes giving scores to only a subset of health plan members. See page 4, paragraph 39 ("...[A]ll of the patients in a particular sub-population have their records scored..."). In particular, Lash gives scores to members of a homogenous group with a common disease, not to each member of a health plan as claimed.

Specifically, Lash discloses a method for predicting the likelihood that a patient diagnosed with a specific disease or medical condition will become a high user of medical services. In practice, prior to performing any analysis on the member patients in a managed care organization, the method of Lash first filters the patient members into a "homogenous sub-population" by disease or diagnosed condition, such as asthma patients or diabetic patients. Page 4, paragraph 37, lines 25-34 ("if the population is not otherwise homogeneous, it is filtered, for example on the basis of the disease or diagnosed condition of the patient to filter the population into more homogeneous sub-populations . . ."); see also, page 5, paragraph 46, lines 12-15,

paragraph 48, lines 8-10; see also, Fig. 3, element 65, Fig. 3A, element 65A and Fig. 3B, element 65B. Only after patient members are filtered based on disease or condition does Lash provide scores to the subset of the members of the health plan in an effort to identify future high users of medical services from the homogenized set of patients. See page 4, paragraph 39 (“...[A]ll of the patients in a particular sub-population have their records scored in step 67, i.e., they are given a score based on the individual values for their predictive variables. The higher the score, the more likely they are to be high-use patients.”); see also page 4, paragraph 38 (“Once a homogeneous population or sub-population of patients is identified, then the regression analysis program operates . . . to predict whether the patient will be a high user of medical service . . .”).

Because the method of Lash first filters the patient members into a “homogenous sub-population” by disease or diagnosed condition prior to performing any analysis on the member patients in a managed care organization, the reference fails to teach computing scores for each member of a health plan as claimed. For at least the foregoing reasons, claims 1-5, 16, 18-24, 27-32, 36-37, and 39-47 are not anticipated by Lash. Independent claims 48 and 49 are not anticipated by Lash for substantially the same reasons. Reconsideration and allowance of these claims are respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 6-15, 17, 25-26, 33-34, and 38 were rejected under 35 U.S.C. § 103(a) as follows: claims 6-15 and 25-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lash (US 2001/0020229 A1) as applied to claim 1, and further in view of Wong et al.. (5,976,082); claims 17 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lash (US 2001/0020229 A1) as applied to claim 1; and claims 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lash (US 2001/00200229) as applied to claim 1, and further in view of Lockwood (5,706,441).

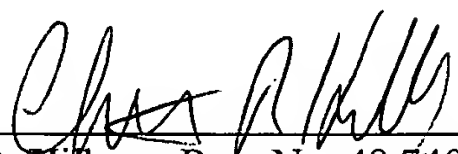
Each of these claims is allowable as depending from allowable claim 1 for at the reasons provided above.

This application now stands in allowable form and reconsideration and allowance are respectfully requested.

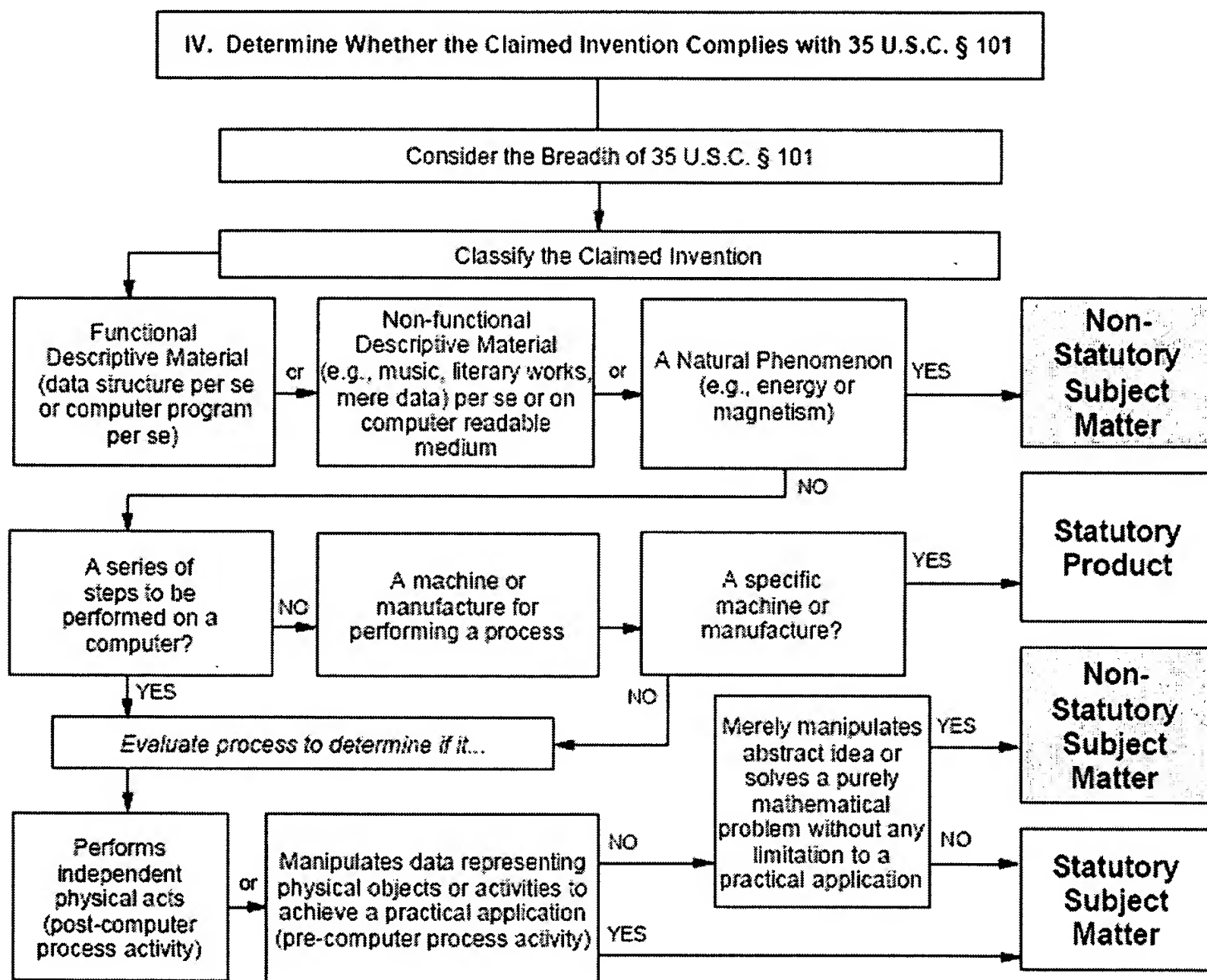
Respectfully submitted,

DORSEY & WHITNEY LLP  
Customer Number 25763

Date: January 17, 2006

By:   
Chris R. Hilberg, Reg. No. 48,740  
(612) 492-6694

**APPENDIX A**



Examination Guidelines for Computer-Related Inventions, Patent and Trademark Office, A-2

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